

In re Application of MAGARAM et al.
Serial No. 09/332,459

REMARKS

The Office action has been carefully considered. The Office action rejected claims 1, 3-9, 11-29, and 31-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,012,044 to Maggioncalda et al. ("Maggioncalda").

Applicants respectfully disagree.

Please note that in previous Office actions and Office action responses, certain claims were erroneously referred to by the incorrect numbers. In essence, claims 17-19 were regarded as claims 18-20 and claims 20-33 were regarded as claims 21-33 by both the previous Office actions and previous Office action responses. The arguments and the language used in both the previous Office actions and subsequent responses both referred to the correct language but did not refer to the correct claim numbers. This incorrect number referencing was brought attention in the last Office action response and is reiterated here. Further, please note that claim 29 has never been entered by number as the originally filed patent application inadvertently skipped this claim. Thus, claim 29 is not pending and never has been pending. As such, a listing of the claims is presented (though no amendments are made at present) that reflect the true and correct numbering and show the current status as well as language that reflects all previous amendments. All remarks below refer to the true and correct claim numbers.

Applicants thank the Examiner for the interview held (by telephone) on July 19, 2004. During the interview, the Examiner and applicants' attorney discussed the claims with respect to the prior art. The essence of applicants' position is incorporated in the remarks below.

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Prior to discussing reasons why applicants believe that the claims in this application are clearly allowable in view of the teachings of the cited and applied references, a brief description of the present invention is presented.

The present invention is generally directed toward a financial or other planning system and method in which hierarchically arranged objects are created and maintained to form a plan. The hierarchical arrangement enables objects to be dependent on other objects, while within the objects are fields that can be related to other fields, e.g., dates, dollar amounts, interest rates and so on. Significantly, the user of the system and method need not be concerned with the dependencies / relationships among objects and fields, but rather simply selects elements and enters data for those elements, and thereafter lets the objects of the system and method handle the dependencies. Thus, unlike simple programming techniques, a user simply responds to questions via a user interface, fills in information and/or makes selections related to the plan. The system then writes the proper information into the hierarchically arranged objects for the user, and manages the relationships for the user. A planning engine runs a simulation based on the data in the objects.

The combination of hierarchical objects relationships and relative field values allows a great deal of flexibility in creating what may be a very complex data system, which can then be used to calculate the results of the user's financial plan over time, as well as making it fairly straightforward for the user to make changes to and update a plan.

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Moreover, via simple interaction with the user interface, a user can selectively disable objects and/or fields, which automatically disables additional objects and fields that are dependent on the directly disabled ones. This facilitates the running of various "what-if" type simulations, to determine the expected consequences of various possible actions.

Note that the above description is for example and informational purposes only, and should not be used to interpret the claims, which are discussed below.

Turning to the claims, independent claim 1 recites a computer-readable medium having computer-executable instructions, comprising, receiving input of a value corresponding to a first field of a first object that maintains plan data, receiving additional input corresponding to a second field of a second object that maintains plan data, receiving input that defines a hierarchical relationship between the first and second objects such that a value in the second field is at least partially based on the first field as a result of the hierarchical relationship, developing a plan by running a simulation on objects that maintain the plan data including the first and second objects, receiving input of a new value for the first field, and developing a new plan by running a simulation on objects that maintain the plan data, including the first and second objects, in which in the new plan, the new value changes the information in the second field.

The Office action rejected claim 1 as unpatentable over Maggioncalda. More specifically, the Office action contends that Maggioncalda teaches several of the recitations of claim 1 by reference to figures 4, 8, and 9, and column 10, line 15 to column 11, line 35 of Maggioncalda. The Office action acknowledges that

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Maggioncalda fails to teach an input that defines a hierarchical relationship between the first object and the second object such that a value in the second field is at least partially based on the first field as a result of the hierarchical relationship. However, the Office action contends that this concept is well known in the art and to combine this known programming standard with Maggioncalda would have been obvious to a person skilled in the art at the time the invention was made. In essence, the Office action is contending that this concept is well known without any reference whatsoever to any art at the time the invention was made. Applicants respectfully disagree.

To establish prima facie obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art; (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)), and "all words in a claim must be considered in judging the patentability of that claim against the prior art;" (*In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997). Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible. See MPEP § 2143.01.

Applicants submit that the Office action has failed to establish a prima facie case for obviousness. In particular, the Office action contends that it is well known in the art to use an input that defines a hierarchical relationship between the first object and the second object such that a value in the second field is at least

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partially based on the first field as a result of the hierarchical relationship. The Office action, however, fails to cite any specific reference to any prior art, but rather falls back on well-known programming standards at the time of the invention. Applicants point out that the invention is not directed to a new programming standard but rather, the recitations of claim 1 are directed to a computer-readable medium having computer-executable instructions, comprising, (among other recitations) receiving inputs in a first field and second field, and additionally receiving an input defining a hierarchical relationship between the first and second fields. The recitations of claim 1 further include a first and second implementation of a plan that utilizes the first and second inputs and the hierarchical relationship. As such, the Office action must consider all the words in the claim language in the context of the entire claim.

Therefore, to the extent that hierarchical relationships are "known programming standards," the same may be said for any step in any new computer-implemented method that comprises "known programming standards." That is, unless the inventor has invented a new programming language, the logic of the Office action would render all possible methods in the computer arts obvious in light of "known programming standards." This logic is overly broad and does not comport with the law with regard to the question of obviousness. Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

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Furthermore, the Office action also contends that the motivation to combine the teachings of Maggioncalda with known programming standards is present because it would provide the system of Maggioncalda the flexibility to create and update the financial plan. This is flawed reasoning. To illustrate the flawed reasoning though an analogy, it would also suggest that any improvement to a car's fuel efficiency would be rendered obvious because it is desirable to have a more fuel efficient car. The motivation to solve a problem does not render the solution to the problem obvious.

Moreover, applicants submit that the Office action is using hindsight reasoning. As a matter of law, obviousness may not be established using hindsight obtained in view of the teachings or suggestions of the applicants. *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 1553, 220 USPQ 303, 311, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). To guard against the use of such impermissible hindsight, obviousness needs to be determined by ascertaining whether the applicable prior art contains any suggestion or motivation for making the modifications in the design of the prior art article in order to produce the claimed design. The mere possibility that a prior art teaching could be modified or combined such that its use would lead to the particular limitations recited in a claim does not make the recited limitation obvious, unless the prior art suggests the desirability of such a modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For at least the foregoing reasons, applicants submit that claim 1 is allowable over the prior art of record.

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Applicants respectfully submit that dependent claims 3-9, 11-16, and 34 by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 1 and consequently includes the recitations of independent claim 1. As discussed above, none of the prior art of record whether considered alone or in any permissible combination, discloses or suggests the recitations of claim 1 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 1 noted above, each of these dependent claims includes additional patentable elements.

For example, claims 5 and 6 were rejected, despite the Office Action having explicitly conceded that Maggioncalda does not teach an amount in one field with a date in another field conditional on the amount. The Office Action's contention that this is well known and therefore, Maggioncalda could be modified, however, fails to consider that having this information in related fields of hierarchically arranged objects eliminates the need for a user to modify the reference in the first place. In fact, this aspect of the present invention is specifically directed towards eliminating the need to modify any prior art as suggested by the Office action. Furthermore, the Office action still fails to cite adequate motivation to combine the teachings of Maggioncalda with known programming standards. Applicants submit that claims 5 and 6 are allowable over the prior art of record for at least these additional reasons.

Turning to the next independent claim, claim 17 recites in a computer system, a method of organizing information related to a plan, comprising, providing access to a limited number of objects to a user, each object having fields therein for maintaining plan information, receiving first user input information including a

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value associated with a first field of a first object, and receiving second user input information associated with a second field of a second object, the second input information specifying a relationship of the second field with the first field, disabling at least one object, and developing a plan including running a simulation that excludes each disabled object.

The Office action rejected claim 17 as unpatentable over Maggioncalda. More specifically, the Office action contends that Maggioncalda teaches each recitation in claim 17 except for synchronizing only the plan elements that have been previously identified for synchronization. Applicants are confused in that claim 17 does not recite this language. As such, the Office action has failed to cite any specific rejection of claim 17. However, to the extent that the Office action intended to reject claim 17 for similar reasons to the rejection of claim 1, applicants respectfully disagree.

Any contention by the Office action that the recitations of claim 17 are well-known programming standards is flawed reasoning. To the extent that the recitations of claim 17 are "known programming standards," the same may be said for any step in any new computer-implemented method comprises "known programming standards." That is, unless an inventor has invented a new programming language, the logic of the Office action would render all possible new methods in the computer arts obvious in light of "known programming standards." This logic is overly broad and does not comport with the law with regard to the question of obviousness. Such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of

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obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Applicants submit that claim 17 is allowable over the prior art of record for at least the foregoing reasons.

Applicants respectfully submit that dependent claims 18-19 and 35, by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 17 and consequently includes the recitations of independent claim 17. As discussed above, none of the prior art of record, whether considered alone or in any permissible combination, discloses or suggests the recitations of claim 17 and therefore these claims are also allowable over the prior art of record. In addition to the recitations of claim 17 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, claim 20 recites a system for outputting a plan, comprising, a user interface for presenting a limited number of plan objects to a user and for receiving data for a first field of a first plan object and data for a second field of a second plan object, the data of the second field having a value linked to the data of the first field via a hierarchical relationship between the first and second objects, the user interface further providing a mechanism that allows plan objects to be selectively disabled, and a planner engine for developing a plan by running a simulation on plan objects while excluding any disabled plan objects.

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The Office action rejected claim 20 for reasons similar to the reasons that claim 1 was rejected. Applicants respectfully disagree and submit that claim 20 should be examined on its own merits.

The Office action's contention that the recitations of claim 20 are well-known programming standards is flawed reasoning. To the extent that the recitations of claim 20 are "known programming standards," the same may be said for any step in any new computer-implemented method comprises "known programming standards." That is, unless an inventor has invented a new programming language, the logic of the Office action would render all possible new methods in the computer arts obvious in light of "known programming standards." This logic is overly broad and does not comport with the law with regard to the question of obviousness. Again, such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Applicants submit that claim 20 is allowable over the prior art of record for at least the foregoing reasons.

Applicants respectfully submit that dependent claims 21-28, 31-33, and 37 by similar analysis, are allowable. Each of these claims depends either directly or indirectly from claim 20 and consequently includes the recitations of independent claim 20. None of the prior art of record, whether considered alone or in any permissible combination, discloses or suggests the recitations of claim 20 and therefore these claims are also allowable over the prior art of record. In addition to

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the recitations of claim 20 noted above, each of these dependent claims includes additional patentable elements.

Turning to the next independent claim, claim 36 recites a computer-readable medium having computer-executable instructions, comprising providing access to a limited number of objects to a user, each object having fields therein for maintaining plan information, receiving first user input information including a value associated with a first field of a first object, receiving second user input information associated with a second field of a second object, the second input information specifying a relationship of the second field with the first field, disabling at least one object, and developing a plan including running a simulation that excludes each disabled object.

The Office action rejected claim 36 for reasons similar to the reasons that claim 1 was rejected. Applicants respectfully disagree.

Any contention by the Office action that the recitations of claim 36 are well known programming standards is flawed reasoning. To the extent that the recitations of claim 36 are "known programming standards," the same may be said for any step in any new computer-implemented method comprises "known programming standards." That is, unless an inventor has invented a new programming language, the logic of the Office action would render all possible new methods in the computer arts obvious in light of "known programming standards." This logic is overly broad and does not comport with the law with regard to the question of obviousness. Once again, such broad, conclusory statements do not come close to adequately addressing the issue of motivation to combine, are not

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evidence of obviousness, and therefore are improper as a matter of law. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Applicants submit that claim 36 is allowable over the prior art of record for at least the foregoing reasons.

For at least these additional reasons, applicants submit that all the claims are patentable over the prior art of record. Reconsideration and withdrawal of the rejections in the Office action is respectfully requested and early allowance of this application is earnestly solicited.

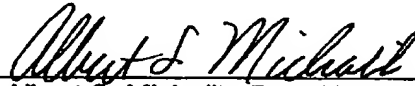
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CONCLUSION

In view of the foregoing remarks, it is respectfully submitted that claims 1, 3-9, 11-28, and 31-37 are patentable over the prior art of record, and that the application is in good and proper form for allowance. A favorable action on the part of the Examiner is earnestly solicited.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney at (425) 836-3030.

Respectfully submitted,



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